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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/608,477	06/30/2000	Marcus Maranhao	50325-0115	2232
29989	7590	05/13/2004		
HICKMAN PALERMO TRUONG & BECKER, LLP 1600 WILLOW STREET SAN JOSE, CA 95125				
			EXAMINER NGUYEN, STEVEN H D	
			ART UNIT 2665	PAPER NUMBER 6
DATE MAILED: 05/13/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/608,477

Applicant(s)

MARANHÃO, MARCUS

Examiner

Steven HD Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/30/00 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-2, 4-9 and 11-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Rabenko (US 2002/0006137).

Regarding claims 1-2, 4-9 and 11-19, Rabenko discloses (Figs 1-16 and Page 1, sec 2 to page 27, Sec 268) a network device that can transmit voice, voiceband data and phone signaling via a network (Fig 1a) comprising a Codec configured to receive analog phone signals and generate digitized voice, and digitized voiceband data (Fig 16, Ref 1608); a SLIC configured to receive analog phone signaling and generate digitized phone signaling (Fig 16, Ref 1610); a network interface for interfacing to an LAN that follows a local area network protocol that supports levels of transmission priority for transmitting data; said network device configured to generate packets that include said digitized voice, digitized voiceband data and digitized phone signaling, wherein said packets conform to a set of protocols that excludes IP; and said network device configured to transmit said packets via said local area network being HPNA using telephone line wherein converting and translating are performing by telephone adapter (Fig 16, Ref 1602, 1604 and 1606 for generating a packet from the received digitized signals such voice, voiceband and signaling according to HPNA protocol version 2 which implicitly support priority

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assigned wherein voice packet has a high priority than the data packet for transmitting via HPNA wherein the IP excludes from LAN; See Pages 2, Sec 32 to Page 3, Sec 47; See Pages 6-7, Sec 74, 77, 78, 80-88; Page 11, sec 120, Page 15, sec 143, 152; Page 16, Sec 160-165, Page 21-26, Sec 216-267).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3, 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabenko in view of Czajkowski (USP 6522647).

Regarding claims 3, 10 and 20, Rabenko discloses a method for transmitting voice over ATM. However, Rabenko does not fully disclose a packet for transmitting via LAN using HPNA protocol is AAL2. In the same field of endeavor, Czajkowski discloses a method for generating the AAL2 packets from the received digitized voice, voiceband and signaling signal to transmitting a telephone line (Fig 2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply an adapter layer such AAL2 for generating a mini packet for transmitting via network as disclosed by Czajkowski's system and method into Rabenko's system and method. The motivation would have been to obtain a bandwidth efficient in the delay sensitive applications.

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5. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edson (USP 6526581) in view of Wallace (USP 6647117).

Regarding claims 1-20, Edson discloses (Figs 1-3 and Col. 1, lines 4 to col. 16, lines 20) a network device that can transmit voice, voiceband data and phone signaling via a network (Fig 4) comprising a Codec configured to receive analog phone signals and generate digitized voice, and digitized voiceband data (Fig 4, Ref 57); a SLIC configured to receive analog phone signaling and generate digitized phone signaling (Fig 4, Ref 56); a network interface for interfacing to an LAN that follows a local area network protocol that supports levels of transmission priority for transmitting data; said network device configured to generate packets that include said digitized voice, digitized voiceband data and digitized phone signaling, wherein said packets conform to a set of protocols; and said network device configured to transmit said packets via said local area network being HPNA using telephone line wherein converting and translating are performing by telephone adapter (Fig 4, Ref 61 and 63 for transmitting and generating a packet includes digitized voice, voiceband and signaling onto HPNA which supports high priority for voice information). However, Edson does not disclose packet being AAL2, which excludes Internet protocol. In the same field of endeavor, Wallace discloses a method and system for transmitting and generating a AAL2 packet includes digitized voice, voiceband and signaling signals onto telephone line (Fig 1, Ref 361 is SLIC, 362 is CODEC and 360 is AAL2; See col. 3, lines 10-57 and col. 5, lines 1 to col. 7, lines 56).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply an adapter layer such AAL2 for generating a mini packet for transmitting via network as disclosed by Wallace's system and method into Edson's system and

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method. The motivation would have been to obtain a bandwidth efficient in the delay sensitive applications.

Response to Arguments

6. Applicant's arguments filed 3/12/04 have been fully considered but they are not persuasive.

In response to page 8, the applicant states that Rabenko fails to teach the packets conform to a set of protocols that excludes Internet protocol. In reply, Rabenko discloses a gateway for converting the physical media and protocols used for internet protocol network to the physical media and protocols used on the home wire pairs such as HPNA protocol (See page 2, sec 33-36, 39-40, 44-47, 85-86, read on the packets on the LAN which are not use IP for transporting the voice. HPNA protocols used to transport the packets) and the provisional applications disclose a gateway for converting the protocols of IP network into a HPNA protocols as claims 1, 8, 15 and 18.

In response to page 9, the applicant states that Rabenko fails to disclose SLIC for generating a digitized phone signaling. In reply, Rabenko discloses SLIC for receiving a DTMF signal and digitizing the DTMF signal before input into a packetizing engine for generating a DTMF packet for transmitting via local area network which uses HPNA protocol as claims 8 and 15 (See sec 162, 164-165, 259 (See Fig 16 of '137, figs 6, 39, 44-47, '057, Figs 6, 39, 44-47).

In response to applicant's argument of pages 10-11 that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some

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teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Rabenko suggests that ATM is used for transporting voice, See 152. and Czajkowski discloses a method and system for using AAL 2 to transport the voice signals which are received from the telephone device. Since AAL 2 is well known and expected in the art for using to transport voice signal over network. The motivation would have been to effectively enhance voice over ATM transport for any voice rates by transporting the small packets, obtain a bandwidth efficient in the delay sensitive applications and multiplexing a plurality of voice channels.

In response to applicant's argument of pages 11-12, that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Edson discloses a gateway for converting the protocol of external network into a protocol of home network such HPNA protocol and an HPNA interface for digitizing the received signaling and voice from the telephone and using the digitized information for generating a packet for transporting via telephone wire. Wallace discloses the use of AAL 2 for generating a packet that contains digitizing signal and voice for transmitting via telephone wire. Since AAL 2 is well known and expected in the art for using to transport voice signal over

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network. The motivation would have been to effectively enhance voice over ATM transport for any voice rates by transporting the small packets, obtain a bandwidth efficient in the delay sensitive applications and multiplexing a plurality of voice channels.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to pages 12-15, the applicant states that Edson and Wallace do not disclose converting analog phone signals into packets for transporting digitizing voice. In reply, Edson discloses a telephone interface for receiving analog voice signal and digitizing analog voice signal into a digital signal for using to generate a voice packet (Fig 4). Wallace discloses an analog telephone for transmitting an analog voice to a codec which generates a digital voice signal and using POTS DSP for generating AAL 2 packet for transporting a digitizing voice (Fig 1, Ref 360-362). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to replay a PAD with AAL 2 in order to generate AAL 2 packet for transporting via a telephone wire. Since AAL 2 is well known and expected in the art for using to transport voice signal over network. The motivation would have been to effectively enhance voice over ATM transport for any voice rates by transporting the small packets, obtain a

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bandwidth efficient in the delay sensitive applications and multiplex a plurality of voice channels.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven HD Nguyen whose telephone number is (703) 308-8848. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D Vu can be reached on (703) 308-6602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven HD Nguyen
Primary Examiner
Art Unit 2665
5/6/04